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PATENTS
ATTORNEY DOCKET NO: 0254-0003**REMARKS****Election/Restrictions**

Non-elected claims 3-8 and 14-19, and claims 12-13, are canceled.

Claim Rejections - 35 U.S.C. Section 103

Claims 1-2 and 9-11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Boatman et al., U.S. Patent 4,074, 188. Reconsideration is requested.

Boatman et al. does not disclose the following from claim 1, as amended: a system for inductance testing a plurality of planar magnetic circuits including a controller “which coordinates the actions of said carriage and said leads so as to implement testing.” Support for the amendment may be found at [0018] and [0024] for example.

Nor does Boatman et al. disclose the following from claim 1, as amended: “wherein, after said selected planar magnetic circuit is tested, said controller positions the leads so that another planar magnetic circuit may be tested.” Support for the amendment may be found at [0027] for example.

In the office action, the Examiner cites the following passage from Boatman regarding a controller: “These drivers are controlled by a decoder 78 that is in turn controlled by a control panel 80 that is operated manually or by suitable software.” (Boatman et al., column 4, lines 45-49.) Boatman et al. further discusses a control panel which controls drivers that control the voltage levels supplied to the leads.

Boatman et al. does not teach or suggest a controller that coordinates the actions of a carriage and implements testing of a plurality of circuit boards, nor does Boatman et al. teach or suggest a controller that, after the selected circuit is tested, positions the leads so that another planar magnetic circuit may be tested.

With regard to claim 2, which depends from claim 1, it should be allowed in consideration of the amendments to claim 1. The Examiner cites to FIG. 2 of Boatman et al. with regard to the additional claim elements of claim 2. The substrate of claim 2 is a separate structure from the planar magnetic circuit that is being tested. In contrast, FIG. 2 of Boatman et al. shows a circuit board 42 with a core 60 merely “placed adjacent to a conductor” (Boatman et al., column 4, lines 17-18); it does not teach or disclose a substrate having a bed for registering a circuit with a core.

Allowance of claims 1-2 is therefore requested.

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With regard to claim 9, the examiner references FIG. 2 of Boatman et al. As noted above, FIG. 2 shows a circuit board 42 with a core 60 merely “placed adjacent to a conductor” (Boatman et al., column 4, lines 17-18); it does not teach or disclose a substrate having an electrically isolated core and bed. Furthermore, Boatman et al. does not teach “loading said board on said bed to register said planar magnetic circuit with said core.” The Examiner cites Boatman et al., column 1, lines 35-40, but this passage discusses testing individual components of a single circuit on a single circuit board. It does not teach loading a circuit board onto a bed to register the circuit with a core as claimed in claim 9.

As discussed with respect to claim 1, the controller disclosed in Boatman et al. is limited to controlling voltage levels. However, in claim 9, the controller controls “contacting said pair of leads with said pair of contacts and said plate with said core,” which is not taught or disclosed in Boatman et al.

Allowance of claim 9 is therefore requested.

Claim 10, which depends from claim 9, should be allowed in consideration of the above discussion pertaining to claim 9. Additionally, claim 10 has been amended, with an example of support for the amendment at paragraph [0022] of the specification.

Claim 11, which depends from claim 9, should be allowed in consideration of the above discussion pertaining to claim 9. The Examiner cites to Boatman et al., column 1, lines 25-29, which discusses replacing a defective component on a circuit board without removing the other components. Boatman et al. does not teach “improving the design of the board to overcome said defect.” For this additional reason, claim 11 should be allowed.

Claim 20 has been added, and it is supported by the specification at paragraph [0023], for example.

The Examiner further stated: “It would have been obvious to one having ordinary skill in the art at the time the invention was made, to test a plurality of circuits since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art,” citing *St. Regis Paper Co. v. Bemis Co.*, 549 F.2d (7th Cir. 1977).

St. Regis Paper Co. does not stand for the proposition that “duplication of essential working parts” would have been obvious to one having ordinary skill in the art at the time the invention was made. Instead, *St. Regis Paper Co.* discusses the now defunct doctrine that new inventions cannot merely rearrange old elements in new combinations, but that they must have a

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synergistic effect. *See, e.g., Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d 963, 967-972 (7th Cir. 1979) (rejecting the “synergistic effect” legal premise).

As discussed above, Boatman et al. does not teach or suggest the claimed invention. Accordingly, none of the claims are obvious on the grounds of “duplication of essential working parts.”

CONCLUSION

For the foregoing reasons, allowance of claims 1, 2, 9-11 and 20 is respectfully solicited. If the Examiner believes it would help to advance the prosecution, the undersigned attorney would welcome the opportunity to discuss the application in a telephone interview and can be reached at (312) 201-0011.

Respectfully submitted,

Dated this 16th day of June, 2006.



Michael T. Griggs
Reg. No. 52,969
BEEM PATENT LAW FIRM
53 W. Jackson Blvd, Suite 1352
Chicago IL 60604-3787
Tel. (312) 201-0011
Fax (312) 201-0022